

Application No. 09/993,780
Amendment "G" dated August 30, 2005
Reply to Office Action mailed July 18, 2005

REMARKS

The Final Office Action mailed July 18, 2005 considered claims 3-8, 13-15, 27-30, and 37-75. Claims 3-8, 13-15, 27-30, and 37-75 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al (6,388,714) in view of Klosterman (5,550,576).¹

Claims 37, 44, 50, 58, and 67 have been amended, claims 76-78 have been newly added such that claims 3-8, 13-15, 27-30, and 37-78 remain pending in the application. The amended claims have essentially been amended to a form that is similar to how they were presented in Amendment "F". Upon further review, Applicant has determined that the claims were clearly patentable over both the art cited in the present Office Action and the Office Action sent on May 9, 2005, particularly in view of the new combination of art that is now being asserted. Arguments demonstrating such patentability follow herein.

Claims 37 and 58 are directed to a method and corresponding computer program product for enabling a server to control the recording of selected television programming. Claims 44 and 50 are directed to a similar method and corresponding computer program product, only recited from the perspective of the client interactive television system.

Each of the recited claims recites either wherein the recording instructions are downloaded from the server through at least one of a television signal and the Internet or wherein the recording instructions are received from the server through at least one of a television signal and the Internet. As described below, the art cited by the Office Action clearly fails to disclose or suggest these limitations, among others.

For example, *Schein* demonstrates a computer accessory (shown in Figure 3) that is capable of controlling a television or a VCR. Col. 6, lines 56-58. The television accessory contains the parameters (date, start time, end time, channel, etc) needed for recording and/or tuning to a selected television program. Col. 6, line 65-Col. 7, line 3. An RF transmitter and corresponding receiver (shown in Figure 4) are used to emit infrared signals to the TV or VCR to control tuning and recording. Col. 7. lines 5-48. Thus, we see in this example, that recording instruction are generated in the computer accessory or received from the computer and not downloaded from a server through one of a television signal and the Internet as is recited by the

¹ Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

Application No. 09/993,780
Amendment "G" dated August 30, 2005
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claims. In fact, *Schien* fails to even disclose that any recording instructions are downloaded at all, let alone from a server, as claimed. In regard to downloading recording instructions, the Examiner has also admitted that *Schein* "fails to disclose a method of obtaining recording instructions to control the recording of one or more selected television programs by the interactive television system specified in claims 3-8, 13-15, 27-30, and 37-69." (Page 4 of the Office Action).

To compensate for this apparent failure of *Schein*, the Examiner has referred to *Klosterman*, as purportedly showing the element of downloading or receiving recording instructions from a server through one of a television signal and the Internet. However, *Klosterman* really discloses no different mechanism than *Schein*, with regard to recording instructions. In particular, *Klosterman* appears to suggest a system that can generate recording instructions by itself, not receiving or downloading recording instructions from a server. Even more particularly, *Klosterman* shows a coordinator 20 that includes an IR emitter 40 which controls one or more of and IRD box 28, a television 22, a VCR 24 and a cable box 26. Col. 4, lines 17-31 and Figure 1A. The coordinator switches between the sources 26, 28, and 30 and provides the output from the desired source to the television. Col. 5, lines 17-20. The coordinator automatically turns on the VCR at the appropriate time, tunes the VCR to the appropriate channel and directs the VCR to begin recording by sending appropriate IR signals. Col. 8, lines 8-64. Thus, it can clearly be seen that the recording information is *generated* at the coordinator and is not, therefore, downloaded or received from a server through one of a television signal and the Internet as is recited by the claims.

In making the rejection, the Examiner asserts that "the recording instructions (e.g. VCR stop time) are downloaded through at least one of a television signal (26-30)." (Page 4 of the office action). However, elements 26-30 are not directed to television signals. Instead, they correspond to a cable box 26, IRD box 28, a satellite dish 29, and other inputs 30, while element 27 does not exist. Accordingly, these elements (26-30) are sources from which programming and EPG data can be received. In particular, in direct contrast to the claimed embodiment, all that is disclosed by *Klosterman* as being received by elements 26, 28, 29 and 30 (cited by the Examiner as being the source of the recording instructions) is television programs and program guide information, not recording instructions. Col. 4, lines 46 and 57-58.

Application No. 09/993,780
Amendment "G" dated August 30, 2005
Reply to Office Action mailed July 18, 2005

Accordingly, even assuming, *arguendo*, that elements 26-30 did correspond directly to television signals being received, and that recording instructions can include a VCR stop time, as purported by the Examiner, there is clearly no suggestion or motivation provided in *Klosterman* for receiving or downloading a VCR stop time with programming that is received from a server. Instead, the recording instructions are generated at the client system, as described above, in response to programming information that is received.

Furthermore, Applicants would also like to point out that if the Examiner intends to use the elements 26-30 as portions of the server system that delivers recording instructions, the Examiner also cannot also use these same elements as part of the client interactive television system, as the recited claims clearly distinguish the two.² In this regard, Applicants respectfully request that the Examiner specifically identify which elements of Schein, *Klosterman*, or any other art, that the Examiner considers to be the server and the client (interactive television system), such that the Applicant will have a fair opportunity to respond to the Examiners rejections inasmuch as Applicant cannot be reasonably expected to hone in on a moving or undefined target.

With further regard to the forgoing discussion, Applicants note that in previous rejections the Examiner has relied on teachings in U.S. Patent 5,485,219 to *Woo*. Although *Woo* is not being relied on in the present rejections, Applicants would also like to reassert that *Woo* like *Klosterman* and *Schein*, also clearly fails to disclose, among other things, recording instructions that are downloaded with the television programming or over the Internet, as claimed. Instead, *Woo* shows a system in which control and programming information is broadcast by a transmitter, which is independent of the television transmitters (110) that broadcast the programming. Presumably, for at least the reasons cited in previous responses and those discussed during previous interviews, this is why *Woo* is no longer being cited by the Examiner.

Furthermore, although the foregoing remarks have been focused primarily on the independent claims, it will be appreciated that all of the remaining rejections and assertions of record with respect to the independent claims, as well as the dependent claims, are now moot,

² *Klosterman* clearly demonstrates, as outlined above, that the elements 26-30 are controlled by the coordinator 20 which, by the Examiners allegations, is receiving recording instructions from the elements 26-30. Accordingly, it is not clear whether elements 26-30 are considered to be part of the server, or the client, as the Examiner's arguments would apparently require both. However, this is not possible, as mentioned above, and such circular demonstration of elements cannot stand.

Application No. 09/993,780
Amendment "G" dated August 30, 2005
Reply to Office Action mailed July 18, 2005

and therefore need not be addressed individually. However, in this regard, it should be appreciated that Applicant does not necessarily acquiesce to any assertions in the previous Office Action that are not specifically addressed above, and hereby reserves the right to challenge those assertions at any appropriate time in the future, should it arise, including any official notice. It is simply just not necessary at this time because the claims are distinguished from the art of record for at least the reasons stated herein.

While, as stated above, the dependent claims do not need to be taken up by the Applicant individually, the same is not true for the Examiner's duty to examine each and every claim whether independent or dependant. Each claim stands on its own and should be examined individually.

For example, with respect to claims 43, 49, 57, and 63 the Examiner has apparently failed to address the limitations where the computing system and the recording device are integrated into a single device. Applicants respectfully request that the Examiner specifically point to the elements in the art that meet these limitations.

Furthermore, with respect to claims 67 and now claim 76³, the Examiner has asserted that the limitation regarding the homepage is taught by a login page. The Examiner also asserts that requiring a user to be screened by a password is met by Figure 14 (see Fig. 14C) of Schein. However, Figure 14C is clearly not directed to a login page, asserted by the Examiner, nor is it a homepage "identifying a plurality of television signal providers" as claimed. Instead, Figure 14 (presumably 14C, since it is the only one showing a password requirement), only deals with verifying or validating a user before consummating a purchase of programming. Accordingly, this clearly does not teach or suggest the limitations recited in the claims.

Applicants would also like to point out how claims 77 and 78 even further distinguish from the cited art of record. In particular, these claims specifically recites that the recording instructions are received or downloaded from the server through a vertical blanking interval (VBI) of the television signal (claim 77) and that the recording instructions are received or downloaded from the server through the Internet (claim 78).

Again, Applicant expressly requests that the Examiner examine these claims with particularity, even though they are only in dependent form.

³ Applicant would further like to point out that new claims 76-78 have been added as dependent claims. Claim 76 places the limitations that were removed from claims 37 into dependent form.

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In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 30 day of August, 2005.

Respectfully submitted,



RICK D. NYDEGGER
Registration No. 28,651
JENS C. JENKINS
Registration No. 44,803
J. LAVAR OLDHAM
Registration No. 53,409
Attorneys for Applicant
Customer No. 047973

RDN:JLD:crb
PPA0000000882V001